

REMARKS

The Examiner has rejected claims 1-5, 7-23, 25-33, 35-46, 48-49, and 50-58 under 35 USC 103(a) as being unpatentable over Blow (WO99/53621) and further in view of Imamatsu (US Pat. Pub. No. 2004/0073901).

Applicant submits that the current office action issued by the Examiner in the present application contains clear errors in the Examiner's rejections as well as omissions of one or more essential elements needed for a prima facie rejection.

The aforementioned rejection is deficient on its face because the Examiner has failed to provide a reason for the purported combination. The Examiner has applied Blow to some steps/elements of independent claims 1, 17, 29, 37, and 42 and has identified other steps/elements that Blow is "silent on". The Examiner then introduces Imamatsu as purportedly teaching the steps/elements that Blow is silent on. However, the Examiner does not explicitly state that Imamatsu actually teaches the steps/elements that Blow admittedly does not. Rather, the Examiner cites a portion of Imamatsu that describes an automatic scanning of apparatuses such that out-of-date software is updated. It is unclear from the Examiner's words just how Imamatsu is applied to the steps/elements not taught by Blow.

Most significant, however, is the fact that the Examiner made no attempt whatsoever to provide a reason for the combination of Blow and Imamatsu. Teachings of Blow are cited and teachings of Imamatsu are cited but there is absolutely no language at all regarding why one of ordinary skill in the art would combine the two references. The rejection, therefore, is deficient on its face regardless of the teachings.

Even in light of recent Supreme Court rulings pertaining to obviousness rejections (which were after the issuance of the present office action), the patent office saw fit to reiterate the standards imposed upon the Examiners in formulating a 35 USC 103 obviousness rejection. A May 3, 2007 memo from the Deputy Commissioner for Patent Operations to Examiners clearly states,

"Therefore, in formulating a rejection under 35 USC 103(a) based upon a combination of prior art elements, it remains necessary to identify the rea-

son why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” (Emphasis Added)

Since the Examiner has failed to meet his obligation under 35 USC 103(a), Applicant requests withdrawal of the rejection of independent claims 1, 17, 29, 37, and 42. Applicant, will, however address the individual merits of the Blow and Imamatsu references while reserving the right to further argue against a combination should the Examiner further pursue this rejection.

With respect to the rejection of independent claims 1, 17, 29, 37, and 42, it is Applicant's belief that the Examiner has extended the teachings of Blow beyond the text of the reference. The claims provide additional steps, processes, and detail that are not contemplated by Blow. For instance, Blow does not teach the complexities involved in the recited claim element of:

“exchanging data between the mobile phone and the mobile phone accessory via the short range communication link, the data pertaining to the one or more software programs resident on the mobile phone accessory including:

the technical requirements of the mobile phone necessary to host and execute the one or more software programs on the mobile phone;

whether the one or more software programs are licensed for use with the mobile phone; and

whether the mobile phone is authorized to host and execute the one or more software programs to be received from the mobile phone accessory,

wherein the data is used to determine which software programs to transfer from the mobile phone accessory to the mobile phone; and

transferring only the one or more software programs from the mobile phone accessory to the mobile phone via the short range communication link that meet the technical, licensing, and authorization requirements necessary to host and execute the one or more software programs on the mobile phone”.

The clause above is included in each independent claim of the present invention. It is directed toward, *inter alia*, determining whether the mobile phone would even be capable of interacting with the accessory assuming the software could subsequently be downloaded and verified (authenticated). This includes things like whether the mobile phone has the underlying software and hardware requirements

necessary to execute the incoming software associated with the accessory such as, for instance, available free storage space, user interface requirements (keyboard), display characteristics (color, color depth, resolution), processing power based on make & model of mobile phone, etc. Support for this construction is found in paragraphs [0010], [0012], [0015], [0016], and [0018] of the present application.

The Examiner has “interpreted” the ‘VALID ACCESSORY’ block of Figure 2, step 204 in Blow as requiring a check of either the characteristics or capabilities of the phone. This is simply not true. Blow is quite clear that ‘valid accessory’ means only one which authenticates properly (see, p. 7, ln. 30). The Examiner’s interpretation clearly exceeds the scope of Blow’s teachings and is an improper extension of the plain language of Blow. The term “valid accessory” is not given any meaningful definition or description in Blow. Moreover, Blow’s process yields a result of ‘presumed valid’ (see, p.5, ln. 25) not a result of actually valid. This is because Blow performs only a single authentication procedure of comparing a secret code shared by the mobile phone and the accessory or, a public key / private key authentication process. All Blow does is ensure that the mobile phone and the accessory contain a key/lock pairing that matches. Any authentication or verification beyond that stated above is beyond the scope of Blow. The Examiner has stretched Blow beyond its reasonable limits to read on clauses in the claims of the present invention such as using technical requirement data to help decide what software programs to transfer. This is neither taught nor disclosed by Blow.

Embodiments of the present invention perform additional operations to ensure the operability such as analyzing the hardware and software functional capabilities of the mobile phone to determine whether the accessory can operate with the mobile phone even if authenticated. Embodiments of the present invention can also determine which version of software (if multiple are available) is best suited for the specific mobile phone to be paired with the accessory. (see, ¶ [0015] of specification). Blow simply does not describe any processes or methods that determine a mobile phone’s capabilities prior to a software exchange with a mobile phone accessory. Blow assumes that the mobile phone is capable and focuses its efforts on authenticating or verifying a code to enable a transfer. An accessory can be valid according to Blow but that does not necessarily mean that it is suited to the mobile phone. The mobile phone may not have enough processing power to operate some

of the features of the accessory. Or, the mobile phone may not possess some of the user interface features (e.g., full keypad, display characteristics, etc...) that would provide the full benefit of the accessory.

The Examiner has relied on the secondary reference of Imamatsu as purportedly teaching the specifics of the data to be exchanged regarding the software on the mobile phone accessory and its potential operability with the mobile phone.

The cited portion of Imamatsu teaches software version updating over a cellular network for software residing on the mobile phone. Since Imamatsu uses the cellular network to perform the check, it is unlikely that the software in question is related to a mobile phone accessory since the "network" has no knowledge of mobile phone accessories being used by the mobile phone. Thus, Imamatsu's teachings are not directed toward mobile phone accessories. Moreover, the cited portion of Imamatsu describes a software version updating procedure which also implies that there is already a version of the software that exists on the mobile phone. The present application details the process of originally loading software for an accessory onto a mobile phone. The accessory may have multiple versions of software available to be loaded on the mobile phone based on the make and model of the mobile phone in question. However, this is not the same as a periodic version updating of system software over a cellular network that is described in Imamatsu. Imamatsu simply does not delve into the detail that is described and claimed in the present application.

The Examiner has stretched Imamatsu's version checking system to read on the present application's claims of using the data to determine which software programs to transfer from the mobile phone accessory to the mobile phone. This does not take into account that the "data" is comprised of much more than what Imamatsu teaches. The present application has claimed that the data also includes licensing information as well as authorization information. The present application considers all the information described and claimed to formulate a decision on whether to transfer one or more software programs.

With respect to the rejection of claims 4, 7, 11-13, 15-16, 22, 32, 45, 48, 53-55, and 57-58 Blow's teachings stop once the software has been downloaded error free to the mobile phone. There is no process of verifying that the downloaded software itself is licensed for use on the mobile phone or been tampered with from its

original incarnation. The Examiner relies too heavily on "Official Notice" as a means for rejecting the claim language without attempting to deal with the specifics involved in verifying licenses and tampering. The Examiner has understated the significance and relevance of software piracy and the efforts to ensure that pirated software can not be executed to control the interaction between the mobile phone and accessory.

Due to the Examiner's heavy reliance on *Official Notice* as a means for rejecting many claims in the present application, Applicant calls for an affidavit from the Examiner under the provisions of 37 CFR §1.104 ("Nature of examination")

The Examiner has conceded that Blow does not disclose verifying the transferred software is licensed for use by the mobile phone, encrypting the software prior to transferring, and the various types of computer scripts or languages (see pp. 4-5 of March 16, 2007 Office Action), and has attempted to overcome the deficiency of the Blow with several assertions - unsupported by any cited reference and without a showing that the Examiner's personal knowledge pre-dates that of the date of filing of the present application - that "it is old and well known in the art that *the use of licenses are well known in the art of software distribution and require a person to buy said license prior to downloading/operating software*", "*transmitting data in encrypted fashion is well known*", and "*mobile phones can download software code/script from remote sites*" (see pp. 4-5 of the March 16, 2007 Office Action).

In respect of the Examiner's unsupported assertion quoted above, applicants hereby require the affidavit of the Examiner under the provisions of 37 CFR §1.104 ("Nature of examination"), which states in paragraph (c)(2) that

"[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command"

and in paragraph (d)(2) requires that

"[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of the employee, and such affidavit shall be sub-

ject to contradiction or explanation by the affidavits of the applicant and other persons.”

Applicant therefore calls for an Examiner's affidavit specifically supporting the Examiner's statement that the aforementioned steps/elements are “old and well known in the art” to support his liberal use of *Official Notice*. In addition, the Examiner's invocation of *Official Notice* is not always directly applied to the steps/elements of the claims at issue.

For instance, the Examiner has used *Official Notice* to generically say that the “use” of licenses is well known in the art whereas the present application claims verifying that a particular license is present in a particular situation. The Examiner's assertion with respect to licenses is much too broad to be meaningfully applied to the present application.

In another example, the Examiner used *Official Notice* in his statement that “*mobile phones can download software code/script from remote sites*”, yet this is never claimed in the present application because “remote sites” are not at issue in the present application.

In sum, Blow teaches downloading software from an accessory to a mobile phone once an optional authentication of the accessory occurs. Verification of the downloaded software involves checking for errors only to the extent that all of the bytes arrived in the proper order such that the software can be executed by the mobile phone. There is no attempt to verify the software itself as being authorized for operation on the mobile phone.

The present disclosure is more complex in that both the mobile phone and the accessory are subjected to multiple authentication and verification procedures prior to and following download. Determinations are initially made whether the mobile phone is capable of even accommodating the accessory. Software is downloaded (encryption is optional) to the mobile phone where it is checked against licenses, and tampering prior to execution.

The Examiner has relied on Blow's ‘authentication’ procedure as reading on the many of the cited clauses of the claims. Applicant believes this to be in error since Blow only describes matching a secret code between mobile phone and accessory and not once throughout the entire disclosure discusses **what** has been authenticated. The secret code procedure of Blow merely describes **how** not what has

been authenticated. The term software license is never mentioned in Blow at all. Nor is there anything alluding to the functional capabilities of the phone to actually handle the accessory. Blow is solely directed toward recognizing that memory is scarce on a mobile phone and pre-loading software for all possible accessories the mobile phone can handle is not something that could be done.

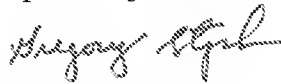
Ironically, Blow does not bother to verify whether the mobile phone itself has enough current memory capacity to store the proposed downloaded software from the accessory. Once authenticated, the mobile phone will simply begin downloading. It is entirely possible that the mobile phone will run out memory before completing the download causing the download to fail. The present invention would not allow such a scenario because it performs a functional check prior to download to ensure the mobile phone has enough memory to accommodate the incoming software.

Thus, Blow and Imamatsu fail to teach all of the recited elements and steps of the present invention either alone or in combination. Applicant requests reconsideration and withdrawal of the 35 USC 102(b) and 35 USC 103(a) rejections of claims 1-58.

The Applicants believe they have responded to all of the concerns raised by the Examiner. Reconsideration of this application as amended is hereby respectfully requested.

The Examiner is authorized to charge any fees required and not paid herein, or credit any overpayment to Deposit Account 13-4365.

Respectfully submitted,



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